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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/714,702 | 11/16/2000 | J. Aaron Bly | 65678-0037 | 5353 |

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EXAMINER

HEWITT II, CALVIN L

ART UNIT PAPER NUMBER

3621

DATE MAILED: 09/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/714,702

Applicant(s)

BLY ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Status of Claims

1. Claims 1-20 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. ^{and 6} Claims 5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 5 recites, "... forms providing data values for the entry of foundational data associated with said data values..." However, the Specification (pages 35 and 36) does not disclose how the data values are used in the entry of foundational data, nor does it [Specification] identify "foundational data".

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 13 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the limitation "said user identification" in lines 3 and 4. There is insufficient antecedent basis for this limitation in the claim as it [claim 13] depends from claim 10, which does not recite "user identification".

Claim 19 recites the limitation "said asset controller" in lines 3-5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-4 and 8-15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Beach et al., U.S. Patent No. 6,084,528.

As per claims 1-4 and 8-15, Beach et al. disclose a system for gathering and analyzing data relating to a movable asset comprising:

- a local controller at a first location for acquiring data that is representative of at least one operating characteristic of an asset (figures 2, 4, 5 and 7A-E)
- an analysis controller (e.g. remote database) located at a second location that is responsive to the acquired data from the local controller for generating an analysis of the acquired data (column 3, lines 45-56; column/line 5/50-6/29; column 7, lines 3-13; column 8, lines 22-67; column 9, lines 9-14; column 17, lines 5-17)
- an electronic communication network for transmitting data from the local controller to the analysis controller (figure 1; column 3, lines 34-56; column 4, lines 58-61; column/line 5/50-6/29)
- a handheld device receiving at least a subset of said acquired data stored in the analysis controller (figures 2, 4, 5 and 7A-E; column 6, lines 1-9; column 9, lines 9-20; column/line 10/64-11/31)
- a handheld device in direct contact with the analysis controller (figure 1; column 6, lines 1-9; column 9, lines 9-20)

- a second computer system that receives acquired data, selectively modifies the acquired data and forwards the modified acquired data to the handheld device (figure 7C; column/line 10/64-11/3; column 12, lines 54-61; column 13, lines 15-46)
- an analysis controller with a database including data values, collected data and comparison data; where the comparison represents a best practice level or past historical data to provide a basis for comparison (column/line 5/50-6/28; column 6, lines 38-64; column 9, lines 9-15; column/line 10/64-11/3)
- data collected that represents a user accessing an asset and user identification or access authorization (e.g. user certification) (column/line 6/30-8/67; column/line 13/60-14/5; column 14, lines 39-50)
- an authorization subsystem for accessing an asset including an asset access mechanism for receiving a user identification from a data transmission point, comparing the user identification with user id stored in a remote database to confirm the identity of the user and permit operation of the asset upon proper authentication (column/line 6/30-8/67; column/line 13/60-14/5; column 14, lines 39-50)

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 18 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ferguson et al., U.S. Patent No. 5,256,863.

As per claim 18, Ferguson et al. teach a retail system for analyzing and gathering data comprising: an asset access device (figures 1 and 3) and a local controller, for acquiring data received from said asset access device that is representative of a request for user authentication, connected to an analysis controller over a communication network that generates an analysis of the request (figure 1; column 20, lines 10-58).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5, 6, 7, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beach et al., U.S. Patent No. 6,084,528 in view of Green et al., U.S. Patent No. 5,664,110.

As per claims 5, 6, 7, 16 and 17, Beach et al. describe a system, using local and analysis controllers, for acquiring and processing data that is representative of a movable asset (figures 1, 2, 4, 5, and 7A-E; column 3, lines 45-56; column/line 5/50-6/29). Beach et al. teach a computer system that provides a portable terminal at a retail facility with a pre-stored shopping list (i.e. data values), uses forms to allow for the entry of data and transmits data to an analysis controller (column 7A-E; column 3, lines 45-47; column 4, lines 6-15; column 8, lines 1-67; column/line 10/64-11/31; column 14, lines 39-67). Beach also teaches delivering to the handheld device inventory or inventory location data (column 14, lines 60-64) and an analysis controller with a database including data values, collected data and comparison data- where the comparison represents a best practice level or past historical data to provide a basis for comparison (column/line 5/50-6/28; column 6, lines 38-64; column 9, lines 9-15; column/line 10/64-11/3). However, Beach et al. do not specifically recite entering foundational data associated with the data values and collecting the foundational data prior to collecting the acquired data. Green et al. teach a data entry system that allows users to access forms for processing pre-stored shopping lists (i.e. data values) (figures 3-5; column 3, lines 50-63; column 6,

lines 30-43). Specifically, users of the Green et al. system can edit (e.g. adjust quantity) the pre-stored list, incorporate the *edited pre-stored list* (i.e. foundational values) into a list currently being constructed (i.e. acquired data) (figure 11; column/line 7/65-8/14). Green et al. also teach transmitting list data to an analysis controller and the analysis controller returning information regarding inventory (column 6, lines 44-54; column 8, lines 35-62; column 12, lines 57-67; column 13, lines 28-34; column 15, lines 42-51). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Beach et al. and Green et al. to allow users with a more efficient method for processing and accessing regularly ordered items ('110, column 3, lines 50-67).

12. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al., U.S. Patent No. 5,256,863 in view of Beach et al., U.S. Patent No. 6,084,528.

As per claims 19 and 20, Ferguson et al. teach an authentication system for obtaining assets using an asset access device and local and analysis controllers (figures 1 and 3; column 20, lines 10-57). Ferguson et al. do not explicitly recite authenticating users based on additional data stored in an asset controller nor do they explicitly recite user certification with respect to a class of assets. Beach et al. authenticate consumers using identification numbers and age to determine whether a consumer is certified to use a class of assets (e.g.

alcoholic beverages). Therefore, it would have been obvious to combine the teachings of Ferguson et al. and Beach et al. in order to prevent ineligible users from purchasing alcoholic beverages at a retail facility ('863, abstract) by alerting the local service attendant at a POS terminal.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- "The Great Equalizer" - www.businessweek.com
- "New lease on truck life: Automated maintenance- Beverage World
- Wright Jr. teaches a system and method for completing an electronic form
- Freeman teaches a materials and supply ordering system using a handheld device
- McCasland teaches a system for performing analysis and repair using a portable device
- Dudle et al. disclose a product estimating and order processing system
- Murphy teaches a vehicle use control system using biometric or indicia data

- Yamamoto et al. disclose a network of controllers for maintaining machines
- Brown et al. teach an off-road vehicle anti-theft system

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

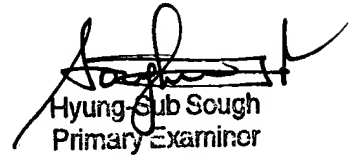
(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451
Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application
should be directed to the Group receptionist whose telephone number is (703)
308-1113.

Calvin Loyd Hewitt II

September 4, 2002



Hyung-Sub Scough
Primary Examiner